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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,213

11/20/2003

Jillian Jacobson-Alti

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EXAMINER

MERCIER, MELISSA S

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,213

Applicant(s)

JACOBSON-ALTI, JILLIAN

Examiner

Melissa S. Mercier

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group II in the reply filed on 6-23-06 is acknowledged. The traversal is on the ground(s) that the groups are not patentably distinct. This is not found persuasive because the compositions comprise different components, which would result in different formulations with distinct properties. However, applicants argument have been considered. The restriction requirement has been modified, claim 1 is now considered to be a linking claim.

The requirement is still deemed proper and is therefore made FINAL.

Additionally, applicant traverses the election of species requirement. The election of species requirement was intended for Group I of the restriction requirement. No election of species requirement was needed for election of Group II.

Claims 1-17 are pending in this application, Claims 3-6, and 11-17 are withdrawn from consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the examiner what the intent of the language "consisting essentially of" is in the claim. Applicant is claiming a composition consisting

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essentially of :an alky ester, a bodying agent, an odorant, a flavorant, and a colorant, however, in dependent claims, applicant further includes additional esters, antioxidants and preservatives.

Claims 1-2 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "an effective amount" is unclear to the examiner how much of each component is in the composition.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, and 7-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Edmundson et al. (US Patent 4,873, 078) and Deckers et al. (US Patent 6,372,234).

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Edmundson teaches a “high gloss, high shine lipstick composition containing cosmetically acceptable waxes, oils, solid and semi solids in admixture with FDA approved dyes and preservatives” (column 2, lines 8-14).

Edmundson teaches suitable cosmetic oils include “isopropyl palmitate, isopropyl myristate, decyl oleate, and mineral oils” (column 2, lines 38-51). Suitable cosmetic waxes “include ozokerite, lanolin wax, beeswax, hydrogenated tallon glycerides and stearic acid and cetylalcohol, fatty acids of lanolin, mono-, di-, and triglycerides, which are solid at 25C, glycol and glycerol” (column 2, lines 15-37).

Edmundson further teaches the addition of “typical flavoring agents including those approved by The Fragrance Institute such as chocolate fudge” (column 2, lines 58-62). Typical suitable dyes include “iron oxides, titanium dioxides, D & C reds, oranges, yellows, and blues” (column 3, lines 19-25).

Regarding Claim 8, Edmundson teaches, typical suitable preservatives include “the lower alkyl esters of para-hydroxybenzoates, especially methylparaben, ethyl paraben, butyl paraben, imidazolidinyl urea and diazolidinyl urea” (column 3, lines 12-18).

Regarding Claim 9, Edmundson teaches, typical antioxidants include “propyl octyl and dodecyl esters of gallic acid, butylated hydroxyanisole, BSH, butylated huydroxytoluene, and nordihydroguaiaretic acid” (column 2, lines 52-57).

Edmundson does not teach the inclusion of an odorant in their lipstick composition. Edmundson also does not teach the use of a fatty acid ester of polyhydric alcohol or specifically sorbitan sesquioleate.

Deckers teaches a cosmetic composition comprising oil bodies suitable for use in lipsticks, lip-glosses, lip balms and lip pencils.

Deckers cosmetic composition further comprises fragrances. Deckers defines a fragrance as any component reacting with the human olfactory sites and imparting a pleasurable odor, essence, or scent. Fragrances taught by Deckers include linear and cyclic alkenes, primary, secondary, and tertiary alcohols, ethers, esters, ketones, nitrites, and saturated and unsaturated aldehydes" (column 17, lines 18-52).

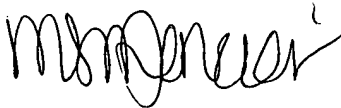
Regarding Claims 7 and 10, Deckers teaches the use of "esters including C₈-C₃₀ alkyl esters of C₈-C₃₀ carboxylic acids; C₁-C₆ diol monoesters and diesters of C₈-C₃₀ carboxylic acids; C₁₀-C₂₀ alcohol monosorbitan esters, C₁₀-C₂₀ alcohol sucrose di- and tri- esters; C₁₀-C₂₀ alcohol sucrose mono-, di-, and tri- esters; and C₁₀-C₂₀ fatty alcohol esters of C₂-C₆ 2 hydroxyacids, examples included sorbitan" (column 16, lines 41-53).

It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components of commonly known to be used in the art of lip stick/gloss compositions. It therefore follows that the instant claims define prime facie obvious subject matter. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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